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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,229	12/12/2003	Sui Xiong Cai	1735.0810001/RWE/RAS	4611

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EXAMINER

AULAKH, CHARANJIT

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 11/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/733,229	Applicant(s) CAI ET AL.	
	Examiner Charanjit S. Aulakh	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-11,13-22,27-49,51-56,58-62,64,65 and 68-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-11,13-22,27-49,51-56,58-62,64,65,68 and 69 is/are rejected.
- 7) ☒ Claim(s) 70 and 71 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. According to paper filed on Oct. 14, 2005, the applicants have canceled claims 4, 12, 23-26, 50, 57, 63, 66 and 67; amended claims 1, 8, 11, 16, 19, 21, 22, 27, 30, 43, 44, 47, 49, 54-56, 61, 62, 65 and 68 and furthermore, have added new claims 69-71.

2. Claims 1-3, 5-11, 13-22, 27-49, 51-56, 58-62, 64, 65 and 68-71 are now pending in the application.

3. Applicant's election of Group I in paper filed on Oct. 14, 2005 is acknowledged.

Because applicant did not specifically and distinctly point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse; see MPEP 818.03(a).

Response to Arguments

4. Applicant's arguments filed on Oct. 14, 2005 have been fully considered but they are not persuasive regarding enablement rejections, indefiniteness rejections and objections. The applicants have amended claims to overcome prior art rejections. In regard to enablement rejection, the examiner does not agree with the applicants arguments that the specification is enabling for treating every known disorder responsive to the induction of apoptosis or treating every known cancer with the instant compounds alone or in combination with thousands of other compounds. The applicants have submitted an affidavit to support the enablement. However, this affidavit is not sufficient for treating every known disorder responsive to the induction of apoptosis or treating every known cancer with the instant compounds alone or in combination with thousands of other compounds. In regard to indefiniteness of the term –prodrug–, the

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applicants have amended claims 1, 27 and 30 to overcome this rejection. However, this amendment introduces new matter as will be discussed later on. On the other hand, the applicants did not amend claims 43-46, 47-56, 58-62, 64, 65 and 68 to include specific prodrugs and furthermore, did not address this issue in their response with respect to these claims. In regard to objection of claims for containing non-elected subject matter, the applicants have partially amended claims to delete the value of variable Q but did not amend claims to delete the values of variables R1-R8 as fused aryl or fused heteroaryl groups according to the elected group I.

NEW GROUNDS OF REJECTION

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 27 and 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicants have amended claims 1, 27 and 30 to include specific prodrugs as mentioned in the specification on page 20, lines 1-11. However, according to the specification on page 20, a carbamate of amino containing compound is not mentioned and therefore, constitutes a new matter.

Conclusion

7. Rejection under 35 U.S.C. 112, first paragraph is maintained for the reasons of record.
8. Rejection under 35 U.S.C. 112, second paragraph for the term ---prodrug--- in claims 43-46, 47-56, 58-62, 64, 65 and 68 is maintained for the reasons of record.
9. Objection of claims for containing non-elected subject matter is maintained for the reasons of record.
10. All prior art rejections are withdrawn in view of amendments.
11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charanjit S. Aulakh whose telephone number is

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(571)272-0678. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on (571)272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Charanjit S. Aulakh
Primary Examiner
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